

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 32

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANDERS LUNDGREN

Appeal No. 2004-0360
Application No. 09/264,398

ON BRIEF¹

Before COHEN, ABRAMS, and McQUADE, Administrative Patent Judges.
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 20-34, which are all of the claims pending in this application.

We AFFIRM.

¹Upon confirmation of his request by counsel for the appellant (Paper No. 31), this case was docketed for oral hearing at 1 PM on March 2, 2004. However, counsel failed to appear at the appointed time and date. Therefore, this appeal has been decided on the Briefs.

BACKGROUND

The appellant's invention relates to a load carrier strut for mounting on load carrier feet disposed at opposing side edges of a vehicle roof. An understanding of the invention can be derived from a reading of exemplary claim 20, which has been reproduced below.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Burland	3,677,451	Jul. 18, 1972
Duemmler	5,275,320	Jan. 4, 1994
Ozog	5,282,560	Feb. 1, 1994
Derecktor	5,848,743	Dec. 15, 1998
Sibinger (German Patent Document)	DE 4,113,230	Oct. 29, 1992

The Examiner's Rejections

Claim 33 stands rejected under 35 U.S.C. § 112, first paragraph,² as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

Claim 33 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellant regards as the invention.

²Rejections of claim 34 under 35 U.S.C. § 112, first and second paragraphs, were withdrawn in the Answer as a result of an amendment after the final rejection.

The following rejections stand under 35 U.S.C. § 102(b):

- (1) Claims 20-32 and 34 as being anticipated by Burland.
- (2) Claim 33 as being anticipated by Duemmler.

The following rejections stand under 35 U.S.C. § 103(a):

- (1) Claims 20-22, 24, 25, 27 and 34 as being unpatentable over Derecktor in view of Duemmler.
- (2) Claims 20-22, 24, 25, 27, 31, 32 and 34 as being unpatentable over Sibinger in view of Duemmler.
- (3) Claims 20, 21, 24 and 34 as being unpatentable over Ozog in view of Duemmler.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the Answer (Paper No. 22) for the examiner's complete reasoning in support of the rejections, and to the Brief (Paper No. 21) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

Claim 20

An arrangement adapted to be mounted on load carrier feet that are disposed at opposing side edge regions of a vehicle roof, said arrangement comprising:

a load carrier strut having a substantially streamlined outer cross-sectional configuration defined at least partially by an outer contour line and, at opposing end regions thereof, longitudinal slots located on an underside of said load carrier strut, each of said longitudinal slots is adapted to receive a drawbar; and

said outer contour line of said streamlined out cross-sectional configuration being broken at said underside of said load carrier strut by a longitudinal projecting portion having a forward defining surface, a rear defining surface and a bottom surface.

The Rejection Under The First Paragraph Of Section 112

Among the structure defined in claim 33 is “a strut having a substantially rectangular cross-sectional configuration defined at least at partially [sic, at least partially] by an outer contour line” (emphasis added). It is the examiner’s position that this structure was not disclosed in the specification, and therefore the claim runs afoul of the first paragraph of Section 112. We agree.

As described in the specification, the load carrier strut 6 has an outer edge line 7 which defines the streamlined cross section (page 5), and there also is a “rectangular tube profile” which has a front wall 14, a rear wall 15, and upper wall 16 and a bottom wall 12 (page 6). Figure 1 of the appellant’s drawings makes it clear that outer edge line 7 transcribes a substantially elliptical profile which defines the strut, within which is positioned the rectangular tube profile. This being the case, the limitation in claim 33

that the “strut,” which is the entire device to which the claim is directed, has a “substantially rectangular cross-sectional configuration,” is without support in the specification. From our perspective, the cross-sectional configuration of the “strut” is not “substantially rectangular,” but substantially elliptical.

While we have carefully considered the arguments presented by the appellant in opposition to this rejection, they have not persuaded us that the specification discloses both a strut and a tube that forms part of the strut which have substantially rectangular cross-sectional configurations.

The examiner also has taken the position that the slots are not associated with the tube member, and therefore this limitation also is not supported by the specification. We do not agree with this conclusion. Claim 33 is directed to a load carrier “strut.” The claim recites longitudinal slots located on the underside and at opposing end regions of “said strut,” and they are disclosed as being in bottom wall 12 of the rectangular tube. Since the tube described in claim 33 is a component of the strut, the examiner’s conclusion here is in error.

However, since we are in agreement with the examiner on one of the two matters raised here, this rejection of claim 33 is sustained.

The Rejection Under The Second Paragraph Of Section 112

The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). In making this determination, the definiteness of the language employed in the claims must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. Id.

The examiner has explained this rejection in terms of how the rectangular cross-sectional configuration would not meet the objectives set forth in the appellants' specification, that is, that it would not present a "substantially streamlined" profile, as is stated on page 3, for example. As we view claim 33, it requires that the strut, which is the entire claimed device, and the tube member that constitutes a substantially internal component of the strut, both have "substantially rectangular cross-sectional configurations." Such is not described in the specification, and therefore the recitation of two components "of substantially rectangular cross-sectional configuration" causes the claim not to set out the invention with a reasonable degree of precision and particularity, placing one of ordinary skill in the art in the position of being unable to determine its metes and bounds based upon the language of the claim as interpreted in view of the specification. The claim therefore is indefinite. The appellant's arguments have not convinced us otherwise.

This rejection of claim 33 is sustained.

The Rejections Under Section 102

Anticipation under 35 U.S.C. § 102(b) is established only when a single prior art reference discloses, either expressly or under the principles of inherency, each and every element of the claimed invention. See, for example, In re Paulsen, 30 F.3d 1475, 1480-1481, 31 USPQ2d 1671, 1675 (Fed. Cir. 1994) and In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990). Anticipation by a prior art reference does not require either the inventive concept of the claimed subject matter or recognition of inherent properties that may be possessed by the reference. See Verdegaaal Brothers Inc. v. Union Oil Co. of California, 814 F.2d 628, 633, 2 USPQ2d 1051, 1054 (Fed. Cir. 1987). Nor does it require that the reference teach what the applicant is claiming, but only that the claim on appeal "read on" something disclosed in the reference, *i.e.*, all limitations of the claim are found in the reference. See Kalman v. Kimberly-Clark Corp, 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), *cert. denied*, 465 U.S. 1026 (1984).

The first rejection under Section 102 is that claims 20-32 and 34 are anticipated by Burland. The examiner has explained on page 4 of the Answer how the language of claim 20 reads on the load carrier disclosed by Burland in Figure 6. We agree with this analysis. We are not persuaded by the appellant's arguments that it is in error. The fact that the Burland carrier is "mounted differently" than that of the appellants' invention

is of no consequence because all of the subject matter recited in claim 20 “reads on” Burland’s Figure 6. With regard to the argument concerning the drawbar, claim 20 states that the strut has longitudinal struts “adapted to receive a drawbar” (emphasis added). It is our view that even if T-shaped element 44 is for argument’s sake not considered to be a “drawbar,” the slots in the strut are nevertheless appear to be “adapted,” that is, capable of, receiving a drawbar. As for the “longitudinal projecting portion,” the claim does not require that it protrude downwardly, as argued by the appellant, but only that the streamlined outer configuration be “broken at the underside” by a “longitudinally” projecting portion, which clearly is the case in Burland at 47 and 52.

This rejection of claim 20 is sustained. Since the appellant has chosen not to argue the separate patentability of dependent claims 21-32, which depend from claim 20, the rejection of those claims also is sustained.

The only argument advanced by the appellant with regard to independent claim 34 is that the longitudinal slot is not disclosed as receiving a drawbar. However, as we concluded above with regard to claim 20, the slot in Burland appears to be capable of receiving a drawbar, and therefore the reference meets the “adapted to receive” requirement of the claim. This rejection of claim 34 is sustained.

Claim 33 stands rejected as being anticipated by Duemmler. The first argument advanced by the appellant with regard to this rejection is that Duemmler does not disclose longitudinal slots adapted to receive a drawbar, in that the slots in Duemmler

receive a supporting jaw, a clamping screw bolt and a claw, which do not constitute a drawbar (Brief, page 8). We find this argument not to be persuasive because, in our view, the slots are “adapted to receive a drawbar,” that is, they are capable of receiving a drawbar, which is all the claim requires.

The second argument posed by the appellant is that Duemmler does not disclose the required lower projecting portion that protrudes downwardly beyond the contour line (Brief, page 8). Again, we do not agree. Claim 33 recites two elements having a “substantially rectangular cross-sectional configuration.” The first of these is upper of the two rectangular elements shown in Figure 2, which is delineated “at least partially” by the outer contour of the outer top and side surfaces of the portion of the strut that defines internal slot 16. The upper rectangular element terminates at the top of the hollow opening delineated by the numeral 2. Extending downwardly from this point is a second element of substantially rectangular cross-sectional configuration, which has a lower portion protruding downwardly beyond the contour line that defines the upper rectangular portion, with the underside of the lower portion being configured to cooperate with support surfaces.

On the basis of this reading of the claim language on the Duemmler strut it is our conclusion that the subject matter recited in claim 33 is anticipated by Duemmler. This being the case, we will sustain this rejection of claim 33.

The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See, for example, In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a prima facie case of obviousness, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure. See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988).

The first rejection under Section 103 is that claims 20-22, 24, 25, 27 and 34 are unpatentable over the combined teachings of Derecktor and Duemmler. In this rejection the examiner finds all of the claimed subject matter to be disclosed by Derecktor except for the individual slots at each end of the strut. However, the examiner takes the position that it would have been obvious to modify the Derecktor strut by replacing the single full length slot with individual slots at each opposing end region of the strut in view of the teachings of Duemmler, because doing so "would involve mere substitution of one functional equivalent for another and . . . would perform equally well on the Derecktor device" (Answer, page 6). However, one of the objectives

of the Derecktor device is to provide a strut “which is capable of being installed on any size and model van” (column 1, lines 23-25), which in our view would be interpreted by one of ordinary skill in the art to pertain, among other things, to vehicles of different widths. To accomplish this, Derecktor provides a single slot that extends for the entire length of the strut and therefore can accommodate both narrow and wide vehicles.

In the absence of evidence establishing that slots at the opposed ends of the strut would be the functional equivalent of a single slot extending along the entire length of the strut in the Derecktor device and would perform equally well, or would be an improvement to the Derecktor system, we fail to perceive any teaching, suggestion or incentive in either reference which would have led one of ordinary skill in the art to make the examiner’s proposed modification. Therefore, the combined teachings of Derecktor and Duemmler fail to establish a prima facie case of obviousness with regard to the subject matter recited in claim 20, and we will not sustain this rejection. It follows that we also will not sustain the like rejection of claims 21, 22, 24, 25 and 27, which depend from claim 20, or of independent claim 34, which contains the same limitation.

Claims 20-22, 24, 25, 27, 31, 32 and 34 stand rejected as being unpatentable over Sibinger in view of Duemmler. In this rejection, the examiner admits that Sibinger discloses no slots, but expresses the view that it would have been obvious to add slots at the opposed ends “in order to allow attachment of the strut to longitudinal rails on the vehicle to increase utility thereof” (Answer, page 7). We do not agree. Sibinger utilizes

an attachment system in which the opposed ends of the strut (3) are fastened to support feet (2), and discloses no slots in the underside, much less slots at the opposed ends. The examiner has not provided reasons why the proposed modification would increase the utility of the Sibinger device or where suggestion to do so is found. This being the case, from our perspective the suggestion to make the modification proposed by the examiner is found only in the hindsight afforded one who first viewed the appellant's disclosure, which is not a proper basis for a rejection. This rejection of independent claim 20 and dependent claims 21, 22, 24, 25, 27, 31 and 32, as well as that of independent claim 34, is not sustained.

Claims 20, 21, 24 and 34 stand rejected as being unpatentable over Ozog in view of Duemmler, with the examiner's rationale being the same as with Sibinger and Duemmler, that is, while Ozog does not disclose slots in the strut, it would have been obvious to add them to increase the utility of the Ozog device. On the basis of the same reasoning we set forth in refusing to sustain the rejection based upon Sibinger and Duemmler, we also will not sustain this rejection of claims 20, 21, 24 and 34.

CONCLUSION

The rejection of claim 33 under 35 U.S.C. § 112, first paragraph, is sustained.

The rejection of claim 33 under 35 U.S.C. § 112, second paragraph, is sustained.

The rejection of claims 20-32 and 34 under 35 U.S.C. § 102(b) as being anticipated by Burland is sustained.

The rejection of claim 33 under 35 U.S.C. § 102(b) as being anticipated by Duemmler is sustained.

The rejection of claims 20-22, 24, 25, 27 and 34 under 35 U.S.C. § 103(a) as being unpatentable over Derecktor in view of Duemmler is not sustained.

The rejection of claims 20-22, 24, 25, 27, 31, 32 and 34 under 35 U.S.C. § 103(a) as being unpatentable over Sibinger in view of Duemmler is not sustained.

The rejection of claims 20, 21, 24 and 34 under 35 U.S.C. § 103(a) as being unpatentable over Ozog in view of Duemmler is not sustained.

A rejection of each of the claims on appeal having been sustained, the decision of the examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

IRWIN CHARLES COHEN
Administrative Patent Judge

NEAL E. ABRAMS
Administrative Patent Judge

JOHN P. McQUADE
Administrative Patent Judge

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Appeal No. 2003-0360
Application No. 09/264,398

Page 15

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